

In the  
United States Court of Appeals  
For the Ninth Circuit

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FRANCES P. SYRACUSE and NEW WONDER BAG CORPORATION,	} <i>Appellants,</i>
vs. HARRY PARIS, et al.,	
	<i>Appellee.</i>

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Appellants' Opening Brief

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vs.

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*Appellee.*

No. 14800

Appellants' Opening Brief

JURISDICTION

This case is a Federal suit in equity for infringement of United States Letters Patent for an invention, and the jurisdiction of the District Court below is alleged in Paragraph I of the Complaint (Tr. p. 3) as follows:

“This cause of action arises out of the patent laws of the United States of America, U.S.C., Title 35, as amended, as hereinafter more fully appears.”

The jurisdiction of the District Court is admitted by the defendant, Harry Paris, in his Motion For

Summary Judgment, pursuant to Rule 56 of the Federal Rules of Civil Procedure (Tr. pp. 10-11).

The jurisdiction of the District Court is further admitted by the Findings of Fact and Conclusions of Law (Tr. pp. 14-18) and particularly by Finding of Fact (3) (Tr. p. 14) of said lower court.

The jurisdiction of the District Court is finally admitted by the Summary Judgment of said lower court (Tr. pp. 23-24).

This Honorable Court of Appeals has jurisdiction to review the final Summary Judgment of the lower District Court on appeal, pursuant to U.S.C.A., Title 28, Judiciary and Judicial Procedure, Chapter 83—Courts of Appeals, Secs. 1291, 1292(4) and 1294(1).

## **STATEMENT OF THE CASE**

This suit is brought by the plaintiffs, Frances P. Syracuse and New Wonder Bag Corporation, a corporation, against the defendant, Harry Paris, et al., for infringement by said defendant, Harry Paris, of Letters Patent in suit No. 2,533,850, filed September 13, 1947, and issued December 12, 1950, to plaintiff (appellant) Frances P. Syracuse, for an invention in Utility Handbag Having Double Compartment With Individual Closures and Independently Accessible Bottle Pockets.

The plaintiff, Frances P. Syracuse, is a proper party plaintiff, in view of the fact that she is the



patentee of the patent in suit, and held the full right, title and interest in and to said patent from the date of its issue on December 12, 1950, to the date of her assignment of said patent, on January 5, 1951, to her co-plaintiff, New Wonder Bag Corporation, which period of entire ownership of the patent in suit by the plaintiff, Frances P. Syracuse, was within the six years statute of limitation prior to the filing of this suit on October 29, 1953.

The general concept of the invention of the said patent in suit is well stated in the first four introductory paragraphs of the first page, column 1, of said patent as follows:

“The present invention relates to handbags, and more particularly to the type of handbag used to carry diapers, bottles, and other articles required for the care of an infant while traveling or away from home.

The principal object of the invention is to provide a new and useful handbag having separate moisture-proof compartments, one of which is adapted to receive fresh diapers or other clothing, another being for damp or soiled diapers, and still others being provided to hold bottles or other equipment.

Another object of the invention is to provide a handbag having a plurality of compartments, each of which is accessible from the outside, independently of the others, through separate slide fastener closures of the type known popularly as zippers.

A further object of the invention is to provide a hand bag having separate compartments for fresh and soiled diapers, and still other compartments at the ends of the bag for holding bottles in an upright position, said bottle-holding compartments being accessible from the outside of the bag through slide fasteners in the ends thereof without opening the diaper-holding compartments of the bag. Such feature is particularly advantageous when traveling in public conveyances or when in congested public areas, since it eliminates the need for exposing the contents of the bag, and makes it possible to get at the bottle without searching through the interior of the bag. In addition to the convenience mentioned, such segregation of the bottles from the other contents of the bag is desirable because it prevents contamination of the nipples by soiled diapers, and provides positive assurance that the nipples will remain sterile until used.”

Referring to the drawing of the patent in suit the basic features of the invention as disclosed in said patent comprise a rectangular bag, designated 10 in its entirety (Fig. 1), which bag is formed with a pair of longitudinal moisture-proof diaper compartments 33 and 34 (Fig. 2 of drawing) and a pair of end bottle pockets 50 and 50 formed at the ends, respectively, of said bag 10, (Figs. 1 and 3 of drawing). The longitudinal diaper compartments 33 and 34 are divided by an intermediate moisture-proof partition designated 32. (Figs. 2, 3 and 4). The inside of the bag 10 is lined with a moisture-proof lining 31, prefer-

ably of plastic sheeting, and the partition 32 is preferably formed by two spaced panels or walls 35 and 36 of moisture-proof plastic sheeting. (Figs. 2-4). The compartments 33 and 34 being lined with moisture-proof sheeting 31 one of said compartments is for the purpose of holding clean diapers or clothing, and the other compartment is for receiving damp or soiled diapers or other articles, whereby said clean diapers or clothing in one compartment 33 are prevented by said moisture-proof partition 32 from being dampened or soiled by damp or soiled diapers or other articles in the other compartment 34. The upper ends of the diaper compartments 33 and 34, are provided with longitudinal slits which may be opened or closed by zippers 23 and 24 respectively. (See Figs. 1-4 of patent drawing). The bottle compartments 50 and 50 extend vertically in the ends, respectively, of the bag 10 (Figs. 1 and 3 of patent drawing) and said pockets are adapted to receive and hold nursing milk bottles 51 in erect upstanding position. The ends 16 of the bag 10 are formed with vertically extending openings 44 for the pockets 50 and 50, respectively, through which openings 44 the milk bottles may be introduced into or removed from said pockets 50 and 50 respectively. Said vertical pocket openings 44 and 44 are normally closed by zippers 45 and 45, respectively, but said zippers may be opened, as indicated in Fig. 1 of the drawing, for introducing the milk bottles 51 and 51 into or removable from the pockets 50 and 50, respectively. The bottle pockets 50 and 50 are sepa-

rated from the diaper compartments 33 and 34 by waterproof plastic sheeting 46 (Fig. 3).

From the foregoing description it will be apparent that the handbag 10 provides separate, moisture-proof compartments 33 and 34 for holding clean dry articles in one of said compartments, and damp or soiled articles in the other. Each of said compartments 33, 34 is accessible from the outside through its own "zipper" closure 23 or 24 in the top of the bag, making it possible to get into either compartment without exposing the contents of the other. The two bottle pockets 50-50 in the ends, respectively, of the bag provide convenient receptacles for holding nursing bottles 51 in upright position, said bottles being segregated from the other articles in the bag, so that the nipples of said bottles cannot become contaminated by said other articles. The separate "zippers" 45 of each of the bottle compartments 50 makes it possible to get at either of the bottles 51 without opening the diaper compartments 33 and 34, which is a particularly convenient feature when it becomes necessary to remove or replace a bottle in the bag in congested public areas, or where the light is poor.

## CLAIM OF PATENT IN SUIT

The single claim of the utility patent in suit, No. 2,533,850, with the reference numerals of the patent specification applied to elements, respectively, of said claim, is as follows:

“A handbag (10) for carrying clean and soiled infants' diapers and nursing bottles, comprising a rectangular body having horizontal top and bottom edges, and verticle sides (13 and 14) and ends (16), said top edge having two laterally spaced longitudinally extending openings (23 and 24) formed therein separated by a narrow strip of material (25), a waterproof partition panel (32) within said body dividing the interior thereof into two laterally spaced compartments (33 and 34), one of which is adapted to receive clean diapers, and the other being adapted to receive soiled diapers, the top edge (41) of said panel being attached to the underside of said strip of material (25), closure means for said openings (23 and 24) comprising rows of slide fastener teeth (26) attached to the material along opposite edges of each said openings, the two companionate rows of teeth (26) along the side of each of said (zipper) openings being adapted to intermesh with one another to close the opening, slide means (30) associated with each of said pairs of intermeshing rows of teeth (26), said slide means (30) being selectively operable from the outside of the handbag to open either one of said compartments (33 or 34) without opening the other, each of said ends (16) of said body having a vertically extend-



ing opening 44 formed therein, intermeshing slide fastener teeth (45) attached to the material along both edges of each of said openings (44) whereby the openings can be closed, waterproof plastic sheeting (46) attached to the inside of said handbag body along the inside edges of said end openings (44), said plastic sheeting (46) forming pockets( 50) within the interior of said body in which nursing bottles (51) can be carried entirely separate from said diaper compartments (33 and 34), and protected from contamination, and a slide for operating each of said end slide fasteners (45) from the outside of the bag to provide access to either of said bottle pockets (50) without opening said diaper compartments (33 and 34)."

One of the plaintiffs' handbags, as covered by the patent in suit, was testified to by the defendant, Harry Paris, in his deposition taken by counsel for plaintiffs, July 28, 1954, at Los Angeles, California, on page 1 of his said deposition, which bag is marked Plaintiffs' Exhibit A for identification.

One of the accused handbags of the defendant, Harry Paris, which is charged by the complaint to infringe the claim of the patent in suit, is testified to by said defendant in his deposition on pages 10, 13 and 55 thereof and is marked Plaintiffs' Exhibit B, for identification.

Motion for Summary Judgment, pursuant to Rule 56, Federal Rules of Civil Procedure, was filed September 3, 1954, by the defendant (Tr. pp. 10-13).

Summary Judgment was granted and entered in favor of the defendant. Filed February 11, 1955. Docket and entered February 15, 1955. (Tr. pp. 23-24.)

## STATEMENT OF POINTS RELIED UPON

The Points on Appeal (Tr. p. 32) to this Honorable Court, from the Summary Judgment of the trial court, may be regrouped as the Points Relied Upon by the appellants, as follows:

1. The Summary Judgment of the trial court is contrary to law.

2. The Order of the Summary Judgment of the trial court, to-wit:

“It is Ordered, that said Motion for Summary Judgment be and the same is hereby granted, and judgment is hereby entered herein in favor of the defendant Harry Paris, dismissing this action, with costs and disbursements to be taxed by the Clerk in favor of defendant Harry Paris and against the plaintiffs,”

is contrary to law.

3. Error in holding and adjudging that the single claim of the patent in suit No. 2,533,850, issued December 12, 1950, is invalid and void.

4. Error in failing to hold and adjudge that the single claim of Letters Patent in suit No. 2,533,850, issued December 12, 1950, is good and valid in law.

5. Error in failing to hold and adjudge that the single claim of the patent in suit, No. 2,533,850, issued December 12, 1950, is infringed by the defendant Harry Paris.

6. Error in failing to deny and dismiss the motion for Summary Judgment of the defendant Harry Paris, with costs, disbursements and an attorney's fee taxed against the defendant in favor of plaintiffs.

7. Error of the trial court in exceeding the permissible limits of determination of disputed questions of fact without a trial.

8. Error of the trial court in deciding and adjudging the claim of the mechanical utility patent in suit, No. 2,533,850 to be anticipated by the structurally and functionally different Shanzer ornamental design patent, Des. 147,477.

9. Error of the trial court in deciding and adjudging said mechanical utility patent in suit invalid and void in view of the structurally and functionally different Shanzer ornamental design patent.

10. Error of the trial court in finding (8) that the Commissioner of Patents failed to cite the most pertinent art, including the Shanzer Design patent, Des. 174,477, against the application for the patent in suit.

11. Error of the trial court in failing to find that the presumption is that the Patent Office did its duty and cited the most pertinent prior art against the application for the patent in suit, and considered the



other patents brought forward by defendant's counsel on motion for summary judgment, as new prior art.

12. Error of the trial court in failing to find that the additional patents set up in the Amended Answer by the defendant are not so close to the patent in suit as the prior art patents cited by the Patent Office against the application for the patent in suit, and particularly the patent of Holland, No. 2,447,940, which was cited by the Patent Office.

13. Error of the trial court in its finding 11 that Plaintiffs' patent is a "combination" patent and must be strictly construed, since practically all patents are combination patents, including primary patents like the patent in suit, and primary patents are liberally construed.

14. Error of the trial court in its finding 12 that there is no discovery or patentable invention covered by the patent in suit within the meaning of the patent law.

15. Error of the trial court in its finding 13 that Plaintiffs' device was fully anticipated by the prior art and represents only the skill of a mechanic.

16. Error of the trial court in its finding 14 that the patent in suit and the only claim in said patent are devoid of any patentable novelty and, therefore, invalid.

17. Error of the trial court in its findings 8, 10, 11, 12, 13 and 14, that said findings involve material ques-

tions of fact, over which the trial court was without jurisdiction on motion for summary judgment.

18. Error of the trial court in failing to find that the patent in suit covers a new and patentable combination of elements, which produces novel and useful results and performs new and useful functions over the Design Patent No. 147,477, to M. Shanzer, and thereby covers a patentable invention over said Shanzer design patent.

19. Error of the trial court in rendering summary judgment for the defendant, Harry Paris, and thereby preventing a fair trial of the case on its real merits, at which trial plaintiffs were prepared to prove extraordinary commercial success of the handbag covered by the patent in suit, which superceded all other handbags used for the same purpose and supplied a long-felt want in the handbag art, of which success the defendant, Harry Paris, has derived the substantial benefit by his wilful and wanton infringement of the patent in suit, and by his unfair competition with the plaintiffs in the manufacture and sale of the plaintiffs' meritorious invention covered by their said patent, which infringement and unfair competition of said defendant have destroyed the plaintiffs' business of manufacturing and selling their patented handbag covered by their patent in suit.

20. Error of the trial court in granting defendants' motion for summary judgment in view of the issue of infringement of the patent in suit raised by the pleadings, which issue is an issue of fact.

21. Error of the trial court in granting the defendants' motion for summary judgment merely on the affidavit of defendants' attorney, C. G. Stratton, denying the allegations of the complaint, which did not determine the issues, and particularly the facts of the case, and plaintiffs were not required to file opposing affidavits.

22. Error of the trial court in failing to deny and dismiss the defendant's motion for summary judgment, in view of the presumption of validity of the patent, since the basis of a suit on a patent is not the raw stuff of mere allegations of fact.

23. Error in granting summary judgment in the plaintiffs' patent infringement suit, since a patent in suit is presumed to be valid until proved invalid, beyond a reasonable doubt, and the defendant's single affidavit does not establish any such proof.

24. Error of the trial court in failing to deny the defendant's motion for summary judgment, on the ground that the alleged invalidity of the patent in suit, on its face, was not sufficiently obvious to authorize the trial court to render summary judgment against the plaintiffs dismissing plaintiffs' patent infringement suit.

25. Error of the trial court in granting summary judgment against the plaintiffs, in view of the fact that it was not clearly apparent that there was no issue of infringement of the patent in suit, and the issue of validity of said patent based on the prior art

should not have been determined on motion for summary judgment.

## ARGUMENT

### Points 1, 2, 6 and 21 through 25

Points 1, 2, 6, and 21 through 25 Appellants' Statement of Points Relied Upon in Appellants' Argument, present the gross error of the trial court in granting and ordering summary judgment to the defendant, Harry Paris, against the plaintiffs, contrary to the plaintiffs' meritorious cause of action and prayer for equitable relief of their complaint, and contrary to law, in view of the strong presumption of validity of the patent in suit and the lack of competent evidence to overthrow that presumption, and in view of the obvious fact that the handbag made and sold by said defendant, within the jurisdiction of the lower U. S. District Court, is a "Chinese" copy of and a wilful infringement of the claim sued on of the patent in suit No. 2,533,850.

"The granting of a patent is weighty evidence that the device or method is new and useful and that the patentee was the *first* inventor, and the burden is on the one who challenges validity to negative novelty in the plaintiff's patent. (*Eno v. Prime Mfg. Co.*, 58 P.Q. 681, Mass. S. Ct. (1943): see also, *International Carrier-Call & Tele. Corp. v. Radio Corp.*, 142 F. 2d 443 C.C.A. (1944): *Crosley v. Westinghouse*, 152 F. 2d 895, C.C.A. 3 (1945)."

*Walker on Patents*, Dellers Ed., 1952 Cumulative Supplement, Page 1272.

**Points 3, 4, 8, 9, 10, 11, 12, 21, 24**

The patent in suit of plaintiff, Frances P. Syracuse, No. 2,533,850, for Utility Handbag Having Double Compartment With Individual Closures and Independently Accessible Bottle Pockets, Filed Sept. 13, 1947, and issued Dec. 12, 1950, was pending in the Patent Office for over three years, during which time the application for the patent was subjected to critical and thorough examination by the expert Patent Office examiners, who cited as they were required to do, the nearest prior art relating to the invention covered by said pending patent application for the patent in suit, which prior art included the following patents:

Number, Patentee and Date.

1,136,138.....	Izet—Apr. 20, 1915
1,325,372.....	Penny—Dec. 16, 1919
1,653,246.....	Zichy—Dec. 20, 1927
1,902,313.....	Strubble—Mar. 21, 1933
1,029,686.....	Wehner—Feb. 4, 1936
2,274,718.....	Lyndes, et al.—Mar. 3, 1942
2,447,940.....	Holland—Aug. 24, 1948

In citing the above prior patents there is hardly a doubt that the Patent Office examiners cited the closest and best prior art relating to the patent in suit, since each patent examiner is a specialist in the particular class of inventions and patents which he is



employed to examine, and the U. S. Patent Office is the emporium of the arts and sciences of the world and the best place anywhere for making searches and investigations of patentable inventions. It is significant that despite the citation, by the Patent Office examiner, of the best art, as above listed, that has been found against the patent in suit, said patent was duly and regularly granted and issued by the Patent Office and carries the *strong presumption of validity, which presumption can only be overthrown by proof to the contrary beyond a reasonable doubt. Such proof involves material issues of fact, which cannot be adjudicated on a motion for a summary judgment.*

The only art set up by the defendant, Harry Paris, in addition to the *inapplicable* art set up by said defendant in his Amended Answer, (Tr. pp. 6-7) is the irrelevant Shanzer Design Patent, Des. 147,477, Sept. 9, 1947, set up in the affidavit of said defendant's attorney, C. G. Stratton (Tr. p. 13).

Said affidavit (Tr. pp. 12-13) refers to Defendant's Exhibit "C," which contains the five patents of Shanzer, D-147,477, Nover, 1,235,049, Gale, 1,617,629, Halpin, 2,025,101, and Vasquez, 2,429,856. Said patents were not cited by the Examiner in the Patent Office against the patent in suit No. 2,533,850, but were dug up unofficially as a result of an independent so-called search in the Patent Office by someone, whose qualifications for determining novelty and patentability of inventions are not shown to be better than or as good as the qualifications of the Patent Office

examiner, who carefully examined and allowed the application for the patent in suit. In the motion for summary judgment no patent expert testified to any vital probative facts concerning the patents contained in Defendant's Exhibit "C", which might invalidate the patent in suit. In the last analysis, the defendant's defense of invalidity of the patent in suit rests upon nothing but the uncorroborated affidavit of the defendant's attorney, C. G. Stratton (Tr. pp. 12-13), which did not determine the issues and particularly the facts of the case, and the plaintiffs were not required to file opposing affidavits, and moreover, the defendant's alleged invalidity of the patent in suit was not sufficiently obvious on the face of said patent or in view of the probative inadequacy of the prior art set up by the defendant, to justify the trial court in granting the defendant's motion for summary judgment dismissing the plaintiffs' meritorious suit against the defendant for willfully infringement of the plaintiffs' patent in suit.

The prior patents contained in the Defendant's Exhibit "C" will now be considered in their order.

The first patent of Max Shanzer, Des. 147,477, Sept. 9, 1947, for Combined Bottle and Diaper Utility Bag, Filed Sept. 17, 1946, is a design patent, which protects only its *ornamental design* and nothing else, while the plaintiffs' patent is a *new article of manufacture* and covers a Utility Handbag Having Double Compartments With Individual Closures and Independently Accessible Bottle Pockets, and the plaintiffs' patent

protects its *mechanical structure, operation and use*. The plaintiffs' *utility* patent and the prior Shanzer *design* patent cover entirely *different inventions* and are entirely noncognate. The filing date on the patent in suit, and the filing date on the Shanzer patent, are not necessarily the *dates of invention* of said patents, respectively, and since there is nothing on the face of said patents and no evidence to show whether Shanzer of the Shanzer patent or Syracuse, the patentee of the patent in suit, was the prior inventor, and since the patent in suit was filed on *Sept. 13, 1947, or less than a year* after the Shanzer patent was *issued* on Sept. 9, 1947, the defendant has failed to establish the fact that the Shanzer patent is *prior art* to the patent in suit, and consequently the Shanzer patent is of no probative value whatever, as an anticipation of the patent in suit, and it should be stricken or disregarded as such.

However, it is immaterial what the date of *invention* of the Shanzer patent may be, because the Shanzer patent does not show or describe the *invention* of the patent in suit, as *claimed* in the single claim of said patent on the last page, in the first and second columns of said page of the patent in suit. The claim of the patent in suit claims *two* longitudinal diaper compartments 33 and 34, closed at the top by "zippers" 23 and 24, respectively, and said patent claim, claims two end bottle pockets 50 at the ends, respectively, of the handbag 10, said longitudinal diaper compartments 33 and 34 being divided by a longitudinal *water-*



*proof partition 32, and said end pockets 50 being closed by "zippers" 45 and divided from the ends of said diaper compartments by moisture-proof plastic sheeting partitions 46. The diaper compartments 33 and 34 contain an infant's clean diapers and soiled damp diapers, respectively, and the clean diapers in one compartment are prevented from being contaminated by the soiled damp diapers in the other compartment by the longitudinal moisture-proof partition 32. The end pockets 50 of the handbag 10, contain infants' nursing milk bottles 51, respectively, and the pocket partitions 46 prevent contamination of the milk bottles 51 in the pockets 50 by the soiled damp diapers in a diaper compartment 33 or 34.*

The above-described *mechanical structure* claimed in the patent in suit is not disclosed in the Shanzer design patent, Des. 147,477, and for that reason the Shanzer patent fails to anticipate the claimed structure of the patent in suit. The Shanzer patent discloses only *one* longitudinal diaper compartment for both clean and soiled diapers, and since the Shanzer patent has no longitudinal moisture-proof partition in said single diaper compartment, said Shanzer patent does not have the claimed structure of the patent in suit to *perform the function and accomplish the new result of preventing soiled diapers from soiling the clean diapers* carried at the same time in the handbag. Moreover the Shanzer design patent does not disclose *end waterproof partitions*, such as the *partitions 46* of the patent in suit, to prevent the soiled

diapers in a diaper compartment 33 or 34 from contaminating the milk bottles 51 in the end pockets.

Aside from the fact that the *single* longitudinal zipper closed opening of the Shanzer design patent is no anticipation of the *two zipper-closed openings 23 and 24* of the patent in suit, is the fact that said *single longitudinal* zipper opening of the Shanzer patent was old in the art at the time the Shanzer application for patent was filed on Sept. 17, 1946, in view of the prior *single longitudinal zipper-closed opening in the top of the handbag of the Plaintiffs' Exhibit "X"* (Tr. p. 20) which handbag was given by J. Calvin Brown (Tr. p. 22), as a Christmas present to Alan Franklin a few days before Christmas 1936 (Tr. p. 18), nearly ten years before the filing date, Sept. 17, 1946, of the Shanzer design patent, Des. 147,477. The *single longitudinal zipper* opening of the Shanzer patent was in the *public domain* at the time the plaintiff Syracuse filed her application for the patent in suit on Sept. 13, 1947. The position of counsel for defendant, that there was no invention covered by the patent in suit in providing *two longitudinal zipper-closed* openings in the top of the handbag of the patent in suit, in view of the *single longitudinal zipper-closed* opening in the top of the Shanzer handbag, is not well taken. The *two* zipper-closed openings in the top of the handbag of the patent in suit are not just merely a duplication of the *single* zipper opening in the top of the Shanzer patent handbag, in view of the fact that the *two* zipper-closed openings in the handbag of the patent in suit

lead into two diaper compartments 33 and 34, divided by a waterproof partition 32, in which compartments, respectively, are carried clean diapers and damp soiled diapers and said waterproof partition 32 between said compartments prevents the damp soiled diapers in one compartment from contacting and soiling the clean diapers in the other compartment. This structure *performs a new and useful function and accomplishes a new and useful result, which constitutes a novel and patentable invention.*

*Loom Co. v. Higgins*, 105 U. S. 591.

Even if the Shanzer *design* patent and the *mechanical* patent in suit were identical, which they are not, and the Shanzer patent was prior to the patent in suit, the Shanzer design patent would be no anticipation of or bar to the grant of the *mechanical* patent in suit. On pages 107-108, Sec. 66, Patents for Designs, By Shoemaker, it is stated:

“The Patent Office and the Courts have declared that a design patent was no bar to the grant of a subsequent mechanical patent on the same article. . . . But a design patent and a mechanical patent relate to different subject matter. The first pertains to the *appearance*, while the second relates to the *mechanical structure* of a device, and it is well settled that a *design* and a *mechanical* patent covering the same article of manufacture may *co-exist*.”

The fact that the structure of the Shanzer patent and the patent in suit are not *structurally identical* or

*functionally identical*, in that the Shanzer patent does not have *two* diaper compartments 33 and 34, one for clean and the other for soiled diapers, with a *moisture-proof partition* 32 between said compartments *and with moisture-proof partitions* 46 between said compartments and the *bottle pockets* 50, are additional and controlling reasons why the Shanzer patent does not anticipate and invalidate the patent in suit.

In *Electro Mfg. Co. v. Yellin* (C. C. A. 7), 56 U. S. P. Q. 290, 292, 132 F. (2d) 979, it was held:

“Of course anticipation of a mechanical patent is not established by a *design patent which does not disclose the structure* of the mechanical patent.”

In *Ex parte Hughes and Fletcher*, 1924 C. D. 71, 328 O. G. 6, it was held:

“A design patent cannot be based upon *functional* features of a structure, or at least a design patent can not ever be used to appropriate *per se* the mechanical function.”

“In case of a mechanical (or utility) patent the vital question is ‘What will it do?’, whereas in a design case the corresponding question is ‘How does it look?’ *Rowe v. Blodgett*, 98 O. G. 1286; 1902 C. D. 583; 112 Fed. 61; 50 C. C. A. 120.”

The Shanzer design patent, Des. 147,477 not only fails to disclose the invention of the patent in suit, but fails to disclose any design invention. Plaintiffs’ Exhibit X (Tr. p. 20) with its *single zipper-closed*

*opening along the top* of the handbag and extending downwardly from the top in the *ends* of the bag, anticipates every design feature of the Shanzer patent, except the *two ornamental bows* at diagonal corners on one side of the handbag (Fig. 1 Shanzer patent), which *bows* are not included in the patent in suit.

The remaining patents, in addition to the aforesaid patent to Shanzer, which counsel for defendant alleges were not cited by the examiner in the Patent Office against the application for the patent in suit, and which said counsel assumes were important, but which counsel for plaintiffs contends were not the best art and are immaterial, will now be considered in order. Said remaining prior patents not cited by the Patent Office examiner are considered by the trial court in Finding of Fact 9, which finding counsel for plaintiffs asserts is in error in failing to find in said prior patents the novel and patentable *combination of elements* of the *claim* of the patent in suit. Said remaining patents are as follows:

Nover.....	1,235,049—July 31, 1917
Gale.....	1,617,629—Feb. 15, 1927
Halpin.....	2,025,101—Dec. 24, 1935
Vasquez.....	2,429,856—Oct. 28, 1947

The said Nover patent does not cover a diaper and nursing bottle handbag. It has no zipper-closed openings at the top of the pockets 15 and 28, respectively, nor any moisture-proof partition between said pockets to prevent soiled diapers in one of said pockets from



soiling the clean diapers in said other pocket. Moreover, said Nover patent shows no zipper-closed pockets for nursing bottles at the ends of the handbag nor any moisture-proof partitions between the ends of said diaper compartments and said end bottle pockets, as claimed in the patent in suit.

Said Gale patent is a valise with removable supports 21 for carrying liquid containers 23 in said supports in a large compartment which supports have to be removed from said compartment to permit the valise to carry other articles. The Gale valise has no separate *zipper-closed longitudinal openings in the top thereof for separate compartments*, respectively, nor any zipper-closed pockets in the *ends* of the valise for carrying nursing bottles in said ends, respectively.

The Halpin patent has no *zipper-closed pockets* in the ends, respectively, of the bag for carrying nursing bottles in said pockets, respectively. This receptacle is not intended or suitable for a diaper and nursing handbag. The novel *inventive concept* of the patent in suit is not disclosed in this Halpin patent.

The Vasquez patent for handbag is hexagonal in shape and does not have zipper-closed pockets in the *ends*, respectively, for carrying nursing bottles, which are very important for nursing infants. In the patent in suit there are two diaper compartments 33 and 34, with *zipper-closed openings 23 and 24 in the top* of said compartments, respectively, and said diaper compartments 33 and 34 are divided by a moisture-proof partition 32 there between, which prevents damp soiled

diapers in one of said compartments from contacting and soiling clean diapers in said other compartment. Said *function* of the moisture-proof partition 32 of the patent in suit in *preventing contamination* of the *clean diapers by the soiled diapers* is *a new and useful result*, which is not accomplished or even suggested by the Vasquez patent, in view of the fact that the Vasquez *partitions 12 between the compartments* of the handbag are *not moisture-proof partitions and do not function as such*. The *inventive concept of the invention of the patent in suit* is *not disclosed within the four corners of the Vasquez patent*, or any of the other *unofficial* prior art patents set up by the defendant, which were *not cited* by the Patent Office examiner. There is no question that the patent examiner cited the *best art* against the application for the patent in suit.

In *The Detroit Motor Appliance Co. v. Burk*, 4 F. 2d 118, it was stated:

“It is contended that the Patent Office did not have before it the prior art disclosed by the above-mentioned patents, except Brock and Lancaster. It is true that these two patents are the only citations in the file wrapper; but this is far from proving that the other patents were not considered. The presumption is that the officials of the Patent Office did their duty, and considered the other patents now brought forward as new prior art. There is no evidence dehores these patents, nor is there anything in the patents themselves

which in my judgment should overthrow the presumption."

In *Adler Sign Letter Co. et al., v. Wagner Sign Service, Inc.*, 112 F. 2d 264, the Court of Appeals of the Seventh Circuit, said (p. 267):

"The Bindhammer and Francis Patents were cited in the Patent Office, but not those of Sand and Standish. It is argued by Adler that it follows these two patents were overlooked by the Patent Office and, if the Patent Office had considered them, a different result would have been reached. We do not think it necessarily follows, however, merely from the fact that they were not cited, that they were overlooked. It is just as reasonable to conclude that they were considered and cast aside as not pertinent." (Citing the above *Detroit Motor Appliance* case.)

In the Finding 8 of the trial court that "Providing two top zippers and two top side-by-side compartments would not be invention and would not involve any more than *mechanical skill*," raises the issues of *invention and validity* of the patent in suit, which issues are held by the weight of authority, including the U. S. Court of Appeals, 9th Circuit, to be *issues of fact*, which requires evidence to prove, and *an issue of fact is fatal* to the defendant's motion for summary judgment.

The case of *Hanover Chemical Mfg. Co. v. David Butterick Co.*, 127 F. 2d 888 (1924) rationalizes



whether validity is a question of law or a question of fact, and concludes that validity and infringement are what the Supreme Court called the "ultimate facts" in *United States v. Esnault-Pelterie*, 299 U. S. 201, 205, 57 S. Ct. 159, 81 L. Ed. 123.

The following cases of the Ninth Circuit Court of Appeals treat the question of *invention* as one of *fact*.

*Crowell v. Baker Oil Tool Co.*, 153 F. 2d 972 (1946);

*Maulsby v. Conzevoy*, 161 F. 2d 165 (1947);

*Refrigeration Engineering v. York Corp.*, 168 F. 2d 896 (1948);

*Faulk v. Gibbs*, 174 F. 2d 34 (1948), and

*Pointer v. Six Wheel Corp.*, 177 F. 2d 153.

In *Crowell v. Baker Oil Tool*, *supra*. (9th Cir.), this Court held:

"The question whether or not a new and useful combination is the result of mere *mechanical skill or of inventive faculty* is one of *fact*."

*Thompson Spot Welder Co. v. Ford Motor Co.*, 265 U. S. 445, 448, 449, 44 S. Ct. 533, 68 L. Ed. 1908.

Walker on Patents, Deller's Ed., Sec. 25, pages 112 and 113, states:

"That the question of *invention* is a question of *fact*."

## Point 13

Referring to Finding 11 of the trial court that "Plaintiff patent is a *combination patent* and must be *strictly construed*," it is pointed out that it is rare indeed to find any claim in any patent issued in these modern times that is not a combination patent or *claim* which determines the scope of a patent.

"A *combination* is a union of *elements* which may be *partly old* and *partly new*, or *wholly old* or *wholly new*. But whether *new* or *old*, the *combination* is a *means—an invention*—distinct from them, (the elements). . . . In making the *combination* an inventor has the whole field of mechanics to draw from."

*Leeds & Catlin v. Victor Talking Machine Co.*,  
213 U. S. 318, quoted in *Diamond Rubber  
Co. v. Consol. Tire Co.*, 220 U. S. 428.

In the case of *Eibel Process Co. v. Minnesota and Ontario Paper Co.* (1923), 261 U. S. 45, 63, 43 S. Ct. 279, 79 L. Ed., Chief Justice Taft said:

"In administering the patent law the court first looks into the art, to find what the real merit of the alleged discovery or invention is, and whether it has *advanced the art substantially*. If it has done so, *then the court is liberal in its construction of the patent, to secure to the inventor the reward he deserves.*"

Walker on Patents (Deller's Ed.), Vol. 2, Sec. 247, Page 1212.

See also:

*Pointer v. Sir Wheel Corporation*, 177 F. 2d 153 (C.C.A. 9).

In view of the granting of the patent in suit over the prior art cited against it by the Patent Office examiner, and the failure, as above pointed out, of the unofficial art, set up against said patent by the defendant's counsel to anticipate said patent, it is submitted that the novel *combination claim* of the patent in suit *has advanced the art substantially* and is entitled to a *liberal* construction by this Honorable Court, rather than a *strict* construction of the erroneous finding (11) of the trial court (Tr. p. 17).

### **Points 7, 17, 20 and 25**

The findings 8, 10, 11, 12, 13 and 14 of the trial court obviously involved *genuine issues of material facts*, except as to the amount of damages, and said findings are clearly inhibited by Rule 56(c) of the Federal Rules of Civil Procedure. Moreover, said findings fly in the face of *Hycon Mfg. Co. v. H. Koch & Sons*, 104 U.S.P.Q. 231 (CCA 9), which held:

“The trial court exceeded the permissible limits of determination of disputed facts, questions without trial. . . . An indispensable prerequisite to such a summary judgment, is the absence of a material fact.”

### Points 5, 20 and 25

These points 5, 20 and 25 involve the issue of *infringement*, which is a *question of fact*, and the court should not pass on the question of prior art and validity of the patent in suit, without giving the plaintiff an opportunity to establish his proof at trial. The defendant's proof of prior art and validity necessarily involve the question of *invention*, which is *not obvious on the face of the patent* in suit and is a *question of fact*.

In *Wiel v. N. J. Richman Co., Inc.*, 3 Fed. Rules Service, 56c. 41, page 548, the court held:

" . . . in a case where there appears an infringement, the court should not pass on the question of prior art in the validity of the patent, without giving the plaintiff an opportunity to establish his proofs at trial."

In *American Metal Cap Co. v. Anchor Cap & Closure Corp.*, 20 F. (2d) 725, the court held:

"Only in plainest case can invalidity of patent be ascertained merely on its face so as to authorize dismissal of infringement suit."

Infringement of the patent in suit, by the defendant, clearly appears upon a comparison of the defendant's handbag with the claim of the patent in suit, whereby said claim may be read, element for element, upon the elements, respectively of defendant's handbag, Plaintiffs' Exhibit "B" for Ident., Deposition of

Harry Paris, Pages 10, 13 and 55. Said defendant's handbag is a "Chinese" copy of the patent in suit, and of the plaintiffs' handbag, Plaintiffs' Exhibit "A" for ident., Deposition of Harry Paris, Pages 3, 8 and 9. Said Plaintiffs' Exhibit "A" is plaintiffs' handbag and is sold under the trade name "Tiny Tots Creation Co. of California," (Patent.)

### Point 19

Plaintiffs are prepared to prove extraordinary popularity and commercial success of their patented handbag covered by the patent in suit, which the defendant has surreptitiously appropriated for his own selfish pecuniary benefit and unlawful aggrandizement, at the expense of the patentee plaintiff, Frances P. Syracuse, whose profitable business of manufacturing and selling her patented handbag in suit has been destroyed by the unlawful and unfair competition of the *defendant, Harry Paris*. In the Deposition of said defendant, plaintiffs' former attorney, Geauque, inquired a number of times of said defendant, as to the number of plaintiffs' patented handbags he had sold and the extent of the market demands he had received for the sale of plaintiffs' said patented handbag, but said defendant, Paris, invariably *refused to answer* any questions of the plaintiffs' counsel, Geauque, *on advice of counsel*, and *thereby suppressed all evidence of his extraordinary commercial success in selling the plaintiffs' highly meritorious patented handbag*. Unusual demand for, and commercial success of the plaintiffs' patented handbag, Plaintiffs' said Exhibit

“A”, for Ident., was admitted by defendant, Harry Paris in his deposition, Page 4, in which he testified that *he and about ten manufacturers produced the plaintiffs’ patented handbag*, (Plaintiffs’ Exhibit (“A”).

### Points 14, 15, 16 and 18

In the last analysis, in view of the failure of the prior art not cited by the Patent Office examiner, as carefully considered herein, the findings 12, 13 and 14 of the trial court are clearly in error and should be reversed.

It is easy enough for any one, such as the infringing defendants, *after seeing* the plaintiff’s novel, useful and patented handbag, to assert that it is without the quality of invention, and that *any one could have thought of it*. That, however, is *knowledge after the fact*, or, as Judge Baker in *Regent Mfg. Co. v. Penn. Electrical & Mfg. Co.*, 121 Fed. Rep. 80, 83 (C.C.A. 7th), characterized it, as “*the ex post facto wisdom of the bystander.*”

The courts have many times pondered that issue, as above stated, and the authorities find that *the following factors, which plaintiffs are prepared to prove at a trial of the case, favor invention and patentability*, where the subject matter of the patent—

#### 1. *Has beneficial results.*

Loom v. Higgins, 105 U. S. 580



2. *Has marked superiority.*

Diamond Rubber Co. of N. Y. v. Consolidated Rubber Tire Co., 220 U. S. 428; 131 S. Ct. 444.

3. *Was quickly adopted.*

Benjamin Elec. Mfg. Co. v. Northwestern Elec. Equip. Co., 251 Fed. Rep. 288.

4. *Was generally accepted and used.*

Morgan Eng. Co. v. Alliance Mach. Co., 176 Fed. Rep. 100.

5. *Was used by defendant.*

Farmers Handy Wagon Co. v. Beaver Silo & Box Co., 236 Fed. Rep. 731.

American Carmel Co. v. Glen Rock Stamping Co., 201 Fed. Rep. 363.

6. *Is easy and inexpensive to manufacture.*

Gen. Elec. Co. v. Hill, Wright Electric Co., 174 Fed. Rep. 996.

7. *Overcame objections of prior devices.*

Wellman-Seaver-Morgan Co. v. Wm. Cramp & Sons, Ship & Engine Bldg. Co., 3 Fed. Rep. (2d) 531.

8. *Displaced other devices.*

Minerals Separation, Ltd. et al. v. James M. Hyde, 242 U. S. 261, 37 Sup. Ct., 82.

9. *Was a commercial success.*

Nicholas Power Co. v. C. R. Baird Co., 222 Fed. Rep. 933.

In view of the leading authorities holding that the question of invention and validity of a patent are ques-

tions of fact, it is not surprising that the great majority of motions for summary judgment in patent infringement cases are denied.

Concerning the question of infringement, the *tribute of imitation* of the defendants in infringing the plaintiffs' patent in suit *is the strongest evidence of invention* of said patent.

*Kurtz et al. v. Bell Hat Lining Co., Inc.*, 280

Fed. Rep. 277, 281 (C.C.A. 2).

*Stiner Sales Co. v. Schwartz Sales Co.*, 98 F.

(2d) 999.

## CONCLUSION

It is respectfully submitted that the subject matter of the patent in suit is new, that it constitutes an invalid, and the trial court's summary judgment should be reversed with costs and a reasonable attorney's fee to plaintiffs, that the defendant, Harry Paris should be adjudged to infringe the patent in suit and enjoined from further infringement of said patent.

Dated this 14th day of November, 1955.

ALAN FRANKLIN

*Attorney for Plaintiffs*